

The opinion in support of the decision being entered today was *not* written for publication in and is *not* binding precedent of the Board.

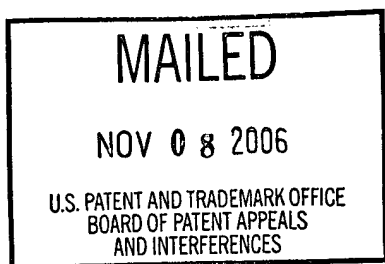
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROY SULLIVAN

Appeal No. 2006-1985
Application No. 09/603,886
Technology Center 3700

ON BRIEF



Before OWENS, CRAWFORD, and LEVY, *Administrative Patent Judges*.
OWENS, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal is from a rejection of claims 33-42. Claims 1-32 have been canceled.

THE INVENTION

The appellant claims a tissue resectioning system which guides a tissue resection device to tissue marked for resection. Claim 33 is illustrative:

33. A tissue resectioning system, comprising:

a resection head mounted at a distal end of an elongate flexible body, the resection head including a marker thereon wherein, when in an operative position, the resection head is located within a body lumen with the elongate flexible body extending through the body lumen to a naturally occurring body orifice;

an imager which remains outside the patient's body, the imager generating image data of a selected region within the patient's body including a predetermined portion of tissue marked for resection;

an image processing unit analyzing the image data to define a region of tissue to be resectioned and to locate the marker; and

a control unit controlling the resection head based on the defined region of tissue and the location of the marker to resect the region of tissue.

THE REFERENCES

Osterholm	4,830,849	May 16, 1989
Aida et al. (Aida)	5,485,839	Jan. 23, 1996
McGuckin, Jr.	5,868,760	Feb. 9, 1999
Murphy-Chutorian	5,891,133	Apr. 6, 1999
Kreizman et al. (Kreizman)	6,214,018	Apr. 10, 2001 (filed Nov. 4, 1998)

THE REJECTIONS

The claims stand rejected under 35 U.S.C. § 103 as follows:
claims 33-36 and 40 over McGuckin, Jr. in view of Murphy-Chutorian; claim 37 over McGuckin, Jr. in view of Murphy-Chutorian and Osterholm; claims 38 and 39 over McGuckin, Jr. in view of Murphy-Chutorian and Aida; and claims 41 and 42 over McGuckin, Jr. in view of Murphy-Chutorian and Kreizman.

OPINION

We reverse the aforementioned rejections. We need to address only the sole independent claim, i.e., claim 33.¹

Claim 33 requires an imager which generates image data of a region that includes a predetermined portion of tissue marked for resection, an image processing unit which analyzes the image data to define a region of tissue to be resected, and a control unit which controls a resection head based in part on the defined region of tissue.

The examiner appears to rely upon McGuckin, Jr. for those claim requirements, but the examiner does not address them with any degree of specificity (answer, page 3). The examiner apparently considers McGuckin, Jr.'s disclosure of diagnostic imaging guidance (abstract; col. 3, lines 55-61) to have fairly suggested those claim requirements to one of ordinary skill in the art. See *id.*

The appellant argues that the disclosure of diagnostic imaging guidance would have fairly suggested visualization to one of ordinary skill in the art, but would not have suggested tissue marked for resection such that it could be distinguished by an imaging device (reply brief, page 3).

¹ The examiner does not rely upon Osterholm, Aida or Kreizman for any disclosure that remedies the deficiency in McGuckin, Jr. and Murphy-Chutorian as to the independent claim.

The appellant's argument is plausible and has not been responded to by the examiner. Consequently, we conclude, based upon the record before us, that the examiner has not carried the burden of establishing a prima facie case of obviousness of the appellant's claimed invention.

DECISION

The rejections under 35 U.S.C. § 103 of claims 33-36 and 40 over McGuckin, Jr. in view of Murphy-Chutorian, claim 37 over McGuckin, Jr. in view of Murphy-Chutorian and Osterholm, claims 38 and 39 over McGuckin, Jr. in view of Murphy-Chutorian and Aida, and claims 41 and 42 over McGuckin, Jr. in view of Murphy-Chutorian and Kreizman, are reversed.

REVERSED

Terry J. Owens
 TERRY J. OWENS)
 Administrative Patent Judge)

Muriel E. Crawford
 MURRIEL E. CRAWFORD)
 Administrative Patent Judge)

Stuart S. Levy
 STUART S. LEVY)
 Administrative Patent Judge)

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